



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,531	08/23/2001	Simon Feldbaek Nielsen	2815-0172P	1443
2292	7590	07/19/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			COLEMAN, BRENDA LIBBY	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	
			1624	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,531

Applicant(s)

NIELSEN ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 19, 20 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

5.00

DETAILED ACTION

Claims 17-20 and 23-25 are pending in the application.

This action is in response to applicants' amendment filed May 2, 2005.

Claims 17-19 were amended and claims 21 and 22 were canceled.

Response to Arguments

Applicants' arguments filed May 2, 2005 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled 3l), 3r) and 3s) maintained in the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejections labeled t), u), v), w), x), y), z) and aa) the applicant's amendments and remarks have been fully considered but they are not persuasive.

t) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. ethylenethio, etc. has been corrected to ethenylenethio. However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. ethenylenethio. Ethenylene is a divalent moiety, so it is not known what is meant by ethenylenethio. It is believed that the applicants intended ethylthio for the moiety ethylenethio.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

u) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. propylenethio, etc. has been corrected to propenylenethio.

Art Unit: 1624

However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. propenyl~~en~~ethio. Propenylene is a divalent moiety, so it is not known what is meant by propenyl~~en~~ethio. It is believed that the applicants intended propylthio for the moiety propylenethio.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

v) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. butyl~~en~~ethio, etc. has been corrected to butenyl~~en~~ethio.

However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. butenyl~~en~~ethio. Butenylene is a divalent moiety, so it is not known what is meant by butenyl~~en~~ethio. It is believed that the applicants intended butylthio for the moiety butylenethio.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

w) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. pentyl~~en~~ethio, etc. has been corrected to pentenyl~~en~~ethio.

However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. pentenyl~~en~~ethio. Pentenylene is a divalent moiety, so it is not known what is meant by pentenyl~~en~~ethio. It is believed that the applicants intended pentylthio for the moiety pentylenethio.

Art Unit: 1624

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

x) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. ethyleneseleno, etc. has been corrected to ethenyleneseleno. However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. ethenyleneseleno. Ethenyleneseleno is a divalent moiety, so it is not known what is meant by ethenyleneseleno. It is believed that the applicants intended ethylseleno for the moiety ethyleneseleno.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

y) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. propyleneseleno, etc. has been corrected to propenyleneseleno. However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. propenyleneseleno. Propenyleneseleno is a divalent moiety, so it is not known what is meant by propenyleneseleno. It is believed that the applicants intended propylseleno for the moiety propyleneseleno.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

z) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. butyleneseleno, etc. has been corrected to butenyleneseleno.

However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. butenyl**eneseleno**. Butenyl**eneseleno** is a divalent moiety, so it is not known what is meant by butenyl**eneseleno**. It is believed that the applicants intended butylseleno for the moiety butyl**eneseleno**.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

aa) The applicants' stated that claim 18 has been amended to correct the nomenclature, i.e. pentyl**eneseleno**, etc. has been corrected to pentenyl**eneseleno**. However, the amendment to claim 18 does not remove the divalency of the moiety, i.e. pentenyl**eneseleno**. Pentenyl**eneseleno** is a divalent moiety, so it is not known what is meant by pentenyl**eneseleno**. It is believed that the applicants intended pentylseleno for the moiety pentyl**eneseleno**.

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejections labeled paragraph 8) of the last office action, which is hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 9) of the last office action, which is hereby **withdrawn**.

Art Unit: 1624

In view of the amendment dated May 2, 2005, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claim 18 is such that the R¹ is ethenyl, propenyl, butenyl and pentenyl which are alkenyl and were not specifically described in the specification with respect to the dimers of formulae II, III and IV.

Applicant is required to cancel the new matter in the reply to this Office action.

Allowable Subject Matter

5. Claims 17, 19, 20 and 23-25 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the dimeric diazepine compounds of formulae (II), (III) and (IV) as claimed herein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

Art Unit: 1624

about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda L. Coleman
Primary Examiner Art Unit 1624
July 15, 2005